

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Jorg G. Schleicher et al.

Serial No. 09/963,812

Filed: 09/26/2001

Examiner: Fadey S. Jabr

Art Unit: 3628

For: **METHOD AND SYSTEM FOR GENERATING REVENUE IN A PEER-TO-PEER  
FILE DELIVERY NETWORK**

Mail Stop Appeal Brief – Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

A **REPLY BRIEF** is filed herewith in response to the Examiner's Answer mailed September 8, 2008. If any fees are required in association with this Reply Brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

## **REPLY BRIEF**

### **A. Introduction**

In response to the Examiner's Answer mailed September 8, 2008, the Appellants submit that claims 1-29 are patentable over the references cited in the Final Office Action mailed February 4, 2008 (hereinafter "Final Office Action"). In particular, none of the cited references, either alone or in combination, disclose the feature of periodically sending subscription-based content to a subscribing client node. In addition, the Patent Office has not shown how the prior art discloses charging a fee to providers of the subscription-based content for serving the subscription-based content.

### **B. Rejections**

In the Final Office Action, claims 1-6, 9-14, 17-22, and 26-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0062290 A1 to *Ricci* (hereinafter "*Ricci*") in view of U.S. Patent No. 5,819,092 to *Ferguson et al.* (hereinafter "*Ferguson*"). In the Final Office Action, the Patent Office also rejected claims 7, 8, 15, 16, and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over *Ricci* in view of *Ferguson* and further in view of the Appellants' Related Art (hereinafter "ARA"). Finally, in the Final Office Action, the Patent Office rejected claims 1-27 under the judicially created doctrine of obviousness-type double patenting as being provisionally unpatentable over claims 16 and 17 of U.S. Patent Application No. 09/814,319 in view of *Ferguson*.

### **C. Arguments**

Claims 1-6, 9-14, 17-22, and 26-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ricci* in view of *Ferguson*. The Appellants respectfully traverse the rejection.

Claim 1 recites a method for generating revenue in a peer-to-peer file delivery network comprising, among other features, "periodically sending the subscription-based content to each respective subscribing client node." Claim 17 includes similar features. The Appellants submit that none of the references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. In maintaining the rejection, the Patent Office asserts that *Ricci* discloses subscription-based content in paragraphs [0064] and [0066], where, according to the Patent Office:

“Further, Ricci discloses the advertisement information (and therefore advertisement) can be selected by matching the recipient’s demographics, interests, and download database, and languages spoken to provide advertisements that would have the greatest impact on the recipient (0064). The server downloads a related advertisement to the recipient... The advertisement can be set to display at various times... the advertisement could also be set to play every time that the digital media is opened (0066). Thus, so far Ricci discloses digital and advertisement information (subscription-based content) and the system sending the information to a user.” (See Examiner’s Answer mailed September 8, 2008, page 13).

Regarding the relied upon disclosure in paragraphs [0064] and [0066], the Appellants respectfully submit that the disclosure in this paragraph is not available as prior art against the present application. More specifically, the present application has a filing date of September 26, 2001, well before the filing date of *Ricci*, which is December 18, 2001. *Ricci* claims the benefit of provisional Application No. 60/252,334 having a filing date of November 22, 2000 (hereinafter “*provisional application*”). As noted above, the Patent Office relies on the following passages in *Ricci*, “advertisement information (and therefore advertisement) can be selected by matching the recipient’s demographics, interests, and download database, and languages spoken to provide advertisements that would have the greatest impact on the recipient” in order to establish that the advertisement information is subscription-based content. The Appellants have reviewed the *provisional application* and submit that the *provisional application* does not disclose “advertisement information (and therefore advertisement) can be selected by matching the recipient’s demographics, interests, and download database, and languages spoken to provide advertisements that would have the greatest impact on the recipient.” Thus, the Patent Office may not rely upon this disclosure in maintaining the rejection.

With reference to the feature of periodically sending the subscription-based content, the Patent Office asserts that *Ricci* discloses this feature in paragraph [0067], where, according to the Patent Office:

“Furthermore, Ricci discloses the server can change the advertisement being sent to prevent repeats (0067). Therefore, Ricci discloses changing advertisements sent to the user, which also indicates, periodically sending the subscription based content to each respective subscribing client node.” (See Examiner’s Answer mailed September 8, 2008, page 13).

The Appellants submit that the Patent Office has cited to a portion of *Ricci* not disclosed in the *provisional application* and is not available as prior art. Specifically, the Appellants have reviewed the *provisional application* and submit that nowhere does the *provisional application* mention anything about advertisements being changed in order to prevent repeats. Thus, for this reason and the reasons noted above, *Ricci* does not disclose periodically sending subscription-based content to a subscribing client node. Moreover, *Ferguson* does not disclose or suggest this feature.

Claim 1 also recites “charging a fee to providers of the subscription-based content for serving the subscription-based content.” Claim 17 includes similar features. The Appellants submit that none of the references, either alone or in combination, disclose charging a fee to providers of subscription-based content for serving the subscription-based content. As correctly pointed out by the Patent Office, *Ricci* does not disclose this feature. (See Examiner’s Answer mailed October 30, 2007, page 4; and Final Office Action, page 8). Similarly, *Ferguson* does not disclose this feature. Nevertheless, the Patent Office supports the rejection by stating that *Ferguson* discloses this feature in col. 4, ll. 53-60. (See Examiner’s Answer mailed September 8, 2008, page 16). The Appellants respectfully disagree. While the cited portion of *Ferguson* does disclose levying fees against third party content owners for submitting advertisements or executing a transaction, *Ferguson* does not disclose, or even suggest, charging a fee for subscription-based content. (See *Ferguson*, col. 4, ll. 53-60). Likewise, the Appellants have reviewed the remaining portions of *Ferguson* and submit that nowhere does the reference disclose this feature. Accordingly, for all the reasons noted above, claims 1 and 17 are patentable over the cited references. Similarly, claims 2-6 and 18-22, which ultimately depend from claim 1 or 17, are patentable for at least the same reasons along with the novel features recited therein.

Claim 9 recites a system for generating revenue in a peer-to-peer file delivery network comprising, among other features, “means for enabling decentralized downloads of subscription-based content that client nodes of the multiple client nodes subscribe to in order to receive periodic updates.” Claim 27 includes similar features. The Appellants respectfully submit that none of the references, either alone or in combination, disclose a means for enabling downloads of subscription-based content in order to receive periodic updates. The Patent Office maintains the rejection by asserting that *Ricci* discloses this feature in paragraph [0067]. (See Examiner’s

Answer mailed September 8, 2008, page 17). As detailed above, the relied upon disclosure in paragraph [0067] of *Ricci* is not available as prior art against the present application. Moreover, as detailed above, none of the references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. Therefore, it follows that neither reference, either alone or in combination, can disclose receiving periodic updates or a means for enabling downloads of subscription-based content in order to receive periodic updates.

Claim 9 also recites that “a fee is charged to providers of subscription-based content for serving the subscription-based content to the client nodes.” Claim 27 includes similar features. The Appellants submit that none of the references, either alone or in combination, disclose or suggest that a fee is charged to providers of subscription-based content for serving subscription-based content. As mentioned above, *Ricci* does not disclose or suggest this feature. In addition, *Ferguson* does not disclose or suggest this feature. The Patent Office maintains the rejection by asserting that *Ferguson* discloses this feature in col. 4, ll. 53-60. (See Examiner’s Answer mailed September 8, 2008, page 16). As detailed above, the cited portion of *Ferguson* does not disclose, or even suggest, charging a fee for subscription-based content. As such, for this reason and the reason noted above, claims 9 and 27 are patentable over the cited references. Similarly, claims 10-14, which ultimately depend from claim 9, are patentable for at least the same reasons along with the novel features recited therein.

Claim 26 recites a method for generating revenue in a peer-to-peer file delivery network, comprising, among other features, “periodically sending the subscription-based content to each respective subscribing client node.” As detailed above, none of the references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. Claim 26 also recites “charging a fee to providers of the subscription-based content for serving the subscription-based content.” As previously discussed, neither *Ricci* nor *Ferguson*, either alone or in combination, discloses charging a fee to providers of the subscription-based content for serving the subscription-based content. For this reason, claim 26 is patentable over the cited references.

Claim 28 recites a system for generating revenue in a peer-to-peer file delivery network comprising, among other features, charging a fee based on a quantity of content served when a client downloads content and then charging a second fee to providers of subscription-based content when subscription-based content is served to client nodes. The Appellants have

reviewed both *Ricci* and *Ferguson* and submit that neither of the references, either alone or in combination, discloses charging a fee based on a quantity of content served when a client downloads content and then charging a second fee to providers of subscription-based content when subscription-based content is served to client nodes. Accordingly, claim 28 is patentable over the cited references.

Claim 29 recites a server node comprising, among other features, charging a fee “to providers of the subscription-based content for providing the subscription-based content to the client node.” As mentioned above, neither *Ricci* nor *Ferguson*, either alone or in combination, discloses charging a fee to providers of subscription-based content for serving subscription-based content. For at least this reason, claim 29 is patentable over the cited references.

In addition, claims 7, 8, 15, 16, and 23-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ricci* in view of *Ferguson* and further in view of the *ARA*. The Appellants respectfully traverse the rejection. Regarding claims 7, 8, 15, 16, 23, and 24, as detailed above, claims 1, 9, and 17, the base claims from which claims 7, 8, 15, 16, 23, and 24 ultimately depend, are patentable over *Ricci* and *Ferguson*. Moreover, the *ARA* does not overcome the previously noted shortcomings of both *Ricci* and *Ferguson*. Therefore, claims 7, 8, 15, 16, 23, and 24 are patentable over the cited references.

Claim 25 recites a method for providing subscription-based decentralized file downloads to client nodes in a peer-to-peer public network comprising, among other features, “periodically delivering the particular content files to respective clients nodes that subscribed to the particular content files.” As detailed above, neither *Ricci* nor *Ferguson*, either alone or in combination, discloses periodically delivering content files to clients that subscribed to particular content files. In addition, the *ARA* does not disclose this feature. Accordingly, claim 25 is patentable over the cited references.

Claims 1-27 were also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16 and 17 of Application No. 09/814,319 in view of *Ferguson*. In an effort to expedite prosecution, the Appellants will file a terminal disclaimer if the pending claims are found to be in a condition of allowance.

### **C. Conclusion**

As detailed above, the Patent Office has not established where the cited references, either alone or in combination, disclose periodically sending subscription-based content to a subscribing client node. Moreover, as shown above, the Patent Office has not shown how the prior art, either alone or in combination, discloses charging a fee to providers of subscription-based content for serving the subscription-based content. Accordingly, the pending claims are patentable over the cited references.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:



Anthony J. Josephson  
Registration No. 45,742  
100 Regency Forest Drive, Suite 160  
Cary, NC 27518  
Telephone: (919) 238-2300

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